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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,132	01/26/2001	Robert Sesek	10004003-1	6720

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EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/771,132	SESEK, ROBERT	

<b>Examiner</b>	<b>Art Unit</b>	
Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 September 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 September 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All
    - b) Some \*
    - c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Application History***

1. This action is responsive to the application amendment, filed on 9/20/2004.
2. Claims 1-20 are pending in the case, claims 1, 7 and 15 are independent claims.
3. Applicant has amended the drawings and the specification in response to the objections cited by the examiner in the *Drawings* and *Specification* sections of the previous office action (dated 6/4/2004/2004). Applicant's amendment has addressed the objections previously made, and therefore, in view of the amendment, objections to the drawings and specification are withdrawn.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."*

5. Claims 1-3, 7-8, 12, 15-16 and 20 remain rejected under 35 U.S.C. 102(e) as being anticipated by Sutcliffe et al. US Patent 6,253,216, filed 6/13/1997, patented 6/26/2001 (hereinafter Sutcliffe).

6. **Regarding independent claim 1**, Sutcliffe discloses a form that has been filled out in Figure 4A at reference sign 188. Sutcliffe also recites: *"The personals-on-line network includes at least one server computer which can be accessed by the remote users. The local computer network also has at least one computer software program and at least one database located therein"* (column 2, lines 35-39) and *"In accordance with the present invention, a system for generating a page for display on a computer system accessible to a plurality of remote users through a computer network includes means for displaying at a user site at least one template, means for inputting user-data*

*to be included in a predetermined area of the template, means for storing the user-data in a predetermined field of a database and means for retrieving the user-data from the database and for displaying the template and the user-data on a display of the computer system" (column 2, lines 21-31).*

7. **Regarding dependent claim 2,** Sutcliffe recites: "One or more of a plurality of remote user terminals 70a-70R generally denoted 70 may access a local computer network 72 by connecting the remote user's computer terminal 70 to a computer network such as the Internet 74" (column 5, lines 59-64), where Sutcliffe identifies the services provided by the internet as "The Internet provides file transfer, remote log in, electronic mail, news and other services" (column 6, lines 3-5).
8. **Regarding dependent claim 3,** Sutcliffe discloses "Create or Edit Personals Page" in Figure 4 at reference sign 164 where the user is shown to "Enter Text" at reference sign 180 (also of Figure 4).
9. **Regarding independent claims 7 and 15,** the claims are directed toward a system of the method of claim 1, and are rejected using the same rationale.
10. **Regarding dependent claims 8 and 16,** the claims are directed toward a system of the method of claim 2, and are rejected using the same rationale.
11. **Regarding dependent claims 12 and 20,** the claims are directed toward a system of the method of claim 3, and are rejected using the same rationale.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."*

13. Claims 4, 9-11 and 17-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sutcliffe in View of Ortiz US Publication 2002/0091937, filed 1/10/2001, published 7/11/2002.

14. **Regarding claims 4, 10 and 11,** Sutcliffe discloses a form creation and transmitting method of personal information as described above. Sutcliffe also describes user verification, but fails to disclose specifically requesting and verifying an identification code, verifying by matching or the use of biometric identification codes. Ortiz discloses the request and verification of the identification code. Ortiz recites: "*host system 48 requests a biometric attribute (i.e., biometric data) from biometric broker 44. Biometric broker 44 returns a biometric attribute or biometric template, which may be compared against sample biometric attribute(s) randomly collected from user 33. This comparison may take place at a number of locations, including at client system 32, at host system 48 or at biometric broker 44. If the sample biometric attribute collected from user 33 matches the biometric attribute retrieved from biometric broker 44, user 33 may be permitted to access*

*resources on host system 48*" (paragraph 53). Ortiz also disclosing "*Biometric attribute match?*" in Figure 5 at reference sign 110.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine user identification of Ortiz with the form creation and transmitting method of personal information of Sutcliffe for the benefit of: "*authenticating user identity and providing secure user access to data and/or transactions*" (Ortiz, paragraph 2).

15. **Regarding dependent claims 9 and 17**, the claims are directed toward a system of the method of claim 4, and are rejected using the same rationale.
16. **Regarding dependent claims 18 and 19**, the claims contain substantially the same subject matter as claims 10 and 11 respectively, and are rejected using the same rationale.
17. Claims 5-6 and 13-14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sutcliffe in View of Yaksich et al. US Patent 5,563,998, filed 10/19/1990, patented 10/8/1996 (hereinafter Yaksich).
18. **Regarding dependent claims 5 and 6**, Sutcliffe discloses a form creation and transmitting method of personal information as described above. Sutcliffe further describes the updating of the form, but fails to disclose re-transmitting a form based upon information updates, or maintaining a list of clients to receive the updated form. Yaksich teaches the re-transmission of forms based upon updates and maintaining a list of receivers. Yaksich recites:

*"According to the invention, the same form may be printed at a number of geographically remote locations on different types of printers, the form can be distributed and updated automatically and efficiently"* (column 1, lines 49-52). Yaksich also discloses in Figure 13b at reference sign NCLP110 a list of clients (shown as "*Customers*") maintained by the system.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the identification and retransmission of updated forms to a list of form receivers, as taught by Yaksich, to the form creation and transmitting of personal information of Sutcliffe in order to provide the benefit of allowing "*the form can be distributed and updated automatically and efficiently*" (Yaksich, column 1, lines 51-52).

19. **Regarding dependent claims 13 and 14,** the claims are directed toward a system of the method of claims 5 and 6 respectively, and are rejected using the same rationale.

***Response to Arguments***

20. Applicant's arguments filed 9/20/2004 have been fully considered but they

are not persuasive.

21. **Regarding claim 1**, the applicant states: "*claim 1 specifies that a form is*

*defined that includes a data entry from each of the data fields in the form*

*profile that are also included in the list in the template*" and "*Sutcliffe fails to*

*show or suggest each of these elements*" (amendment of 9/20/2004, page 6,

second and third paragraphs). Applicant is directed to the rejection of claim 1,

as restated above. In further support of the rejection, Sutcliffe discloses in

Figure 4A, at reference sign 188, a form that has been defined. Sutcliffe's

form has been defined from the data shown in Figure 3 at the database tables

shown at reference signs 126, 134 and 152. Sutcliffe discloses a data entry

for each of the data fields in the template list in Figure 3 at the table

designated by reference sign 134; where the template is designated at

reference sign 136, and the list of data fields are shown at reference sign 140

(shown as "Field Name"), and the data is shown at reference sign 144 (shown

as "Field Attribute").

22. **Also regarding claim 1**, the applicant recites: "Nowhere does Sutcliffe

show or suggest "templates" that include a list that comprises a subset of

data fields in a form profile as claimed" (amendment of 9/20/2004, page 6,

fourth paragraph). Applicant is directed to the rejection of claim 1, as restated

above. In further support of the rejection, Sutcliffe discloses in Figure 3 at the

database table designated by reference sign 134, a plurality of templates at reference sign 136 (shown as “*template1*” and “*template2*”). Sutcliffe discloses a list that comprises a subset of data fields for each template shown in Figure 3 at reference sign 140 (shown as “*Field Name*”)

23. **Also regarding claim 1**, the applicant recites: “*Nowhere does Sutcliffe suggest creating a form that includes data taken from a form profile that corresponds to the data fields listed in a given template*” (amendment of 9/20/2004, page 6, fifth paragraph). In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., “*creating a form*”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
24. **Regarding claims 5 and 6**, the applicant states: “Applicant asserts that the citation to Figure 13b by the Office Action as describing the subject matter of either claims 5 or 6 is improper. For example claim 6 describes maintaining a list in the server of a number of clients to receive one of a number of updated forms. While the portion of Figure 13b states “customer list/update”, it does not show or suggest maintaining a list in the server of a number of clients that are to receive one of a number of updated forms, where such forms were updated due to an update in the form profile as set forth in claim 5

from which claim 6 depends" (amendment of 9/20/2004, page 8, last paragraph to page 9, first paragraph). Applicant is directed to the rejection of claims 5 and 6, as restated above.

***Conclusion***

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

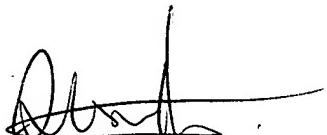
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn  
January 12, 2005



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER